

### **REMARKS/ARGUMENTS**

In view of the foregoing amendments and the following remarks, the applicant respectfully submits that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicant will now address each of the issues raised in the outstanding Office Action.

#### **Rejections under 35 U.S.C. § 103**

Claims 1, 3-10 and 13-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,745,705 ("the Iguchi patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 1, 9, 10, 13, 14 and 24 are not rendered obvious by the Iguchi patent (1) because the Iguchi patent does not teach a POS terminal that does not have execution programs, (2) because the Examiner has not demonstrated that such POS terminals were common knowledge, and (3) because one skilled in the art would

not have been motivated to modify the Iguchi patent in view of the purported common knowledge.

Regarding the first point, the Examiner concedes that the Iguchi patent does not teach a POS terminal that does not have execution programs. As the applicant stated in the previous response:

As shown in Figure 11 of the Iguchi patent, the POS terminals store an execution program, sales data, setting data, etc. (See also, column 6, lines 1 and 2 and column 7, lines 10-49.) Indeed, the Examiner concedes that the Iguchi patent does not teach a POS terminal that does not have execution programs. (See, Paper No. 16, page 2.)

The Examiner contends that (1) the applicant does not contest the fact that the noted common knowledge is not accurate and that the applicant concedes the common knowledge. (See Paper No. 20050222, page 2.) The applicant made no such concession. Rather, in the previous response, the applicant stated:

To compensate for this admitted deficiency, the Examiner argues that maintenance systems with a POS system having "dumb" terminals are common knowledge within the POS art and that it would have been obvious to provide a POS terminal without execution programs in the Iguchi system. (See, Paper No. 16, page 2.) **However, the Examiner does not substantiate his claim of common knowledge in the art, for instance by citing a prior art reference in the rejection of the claims. If the Examiner maintains this rejection in any future actions, the applicant respectfully requests that**

**the Examiner cite a prior art reference  
in any rejections.** [Emphasis added.]

The applicant respectfully submits that this is not a concession. To clear up any possible misinterpretation of the foregoing, the applicant hereby traverses the Examiner's assertion that POS terminals not having execution programs are common knowledge since the applicant is unaware of any such terminals at the time of the invention.

The Examiner cites U.S. Patent No. 6,754,704 ("the Prorock patent") as evidencing his assertion that POS terminals not having execution programs are common knowledge. (See Paper No. 20050222, page 3.) However, the present application has a priority date of February 9, 2000, while the Prorock patent was filed on June 21, 2000. Thus, the Prorock patent is not "prior art" to the instant application and certainly does not support the Examiner's assertion of common knowledge. Thus, the claims are not rendered obvious by the Iguchi patent for at least this reason.

Further, even assuming, arguendo, that POS terminals not having execution programs were in the common knowledge, the Examiner has yet to provide a suggestion in the art for modifying the Iguchi patent. As the applicant stated in the previous response:

the Examiner provides no suggestion for modifying the Iguchi patent as proposed, but merely concludes that providing such a point-of-sale terminal unit would have been obvious. Thus, the Examiner has not established a prima facie case of obviousness. (See MPEP 706.02(j).) If the Examiner

maintains this rejection in any further actions, the applicants respectfully request that the Examiner cite a suggestion, in the prior art, to modify the point-of-sale terminal unit as proposed by the Examiner.

The Examiner concludes that it would have been obvious to provide voice activated POS systems and maintenance systems and a POS terminal not having execution programs for Iguchi because doing so "would provide common knowledge prior art operating systems used with POS systems." (Paper No. 20050222, page 2.) The Examiner also concludes that to have implemented a common knowledge POS terminal for Iguchi "would have been obvious for one of ordinary skill in the art." The applicant respectfully continues to submit that such conclusory, bootstrapped statements are not enough to show obviousness. The case law is clear. Even the MPEP expressly warns against this, stating, in pertinent part:

THE PRIOR ART MUST SUGGEST THE  
DESIRABILITY OF THE CLAIMED INVENTION  
...

[THE] FACT THAT REFERENCES CAN BE  
COMBINED OR MODIFIED IS NOT SUFFICIENT  
TO ESTABLISH PRIMA FACIE OBVIOUSNESS  
...

[THE] FACT THAT THE CLAIMED INVENTION  
IS WITHIN THE CAPABILITIES OF ONE OF  
ORDINARY SKILL IN THE ART IS NOT  
SUFFICIENT BY ITSELF TO ESTABLISH PRIMA  
FACIE OBVIOUSNESS

MPEP 2143.01. In any event, since the Iguchi patent stores the execution program at the register and espouses

processing accounts at the register, one skilled in the art would not have been motivated to modify the Iguchi patent as proposed.

Accordingly, independent claims 1, 9, 10, 13, 14 and 24 are not rendered obvious by the Iguchi patent for at least the foregoing reasons. Since the remaining claims depend, either directly or indirectly, from claims 1, 9, 10, 13 14 and 24, these claims are similarly not rendered obvious by the Iguchi patent.

Further with respect to the dependent claims, the applicant respectfully continues to note that the Examiner still has not addressed the features of these dependent claims, and therefore has not made a prima facie showing of obviousness. If the Examiner maintains this rejection in any further actions, the applicant respectfully requests that the Examiner address each and every feature of the pending claims.

#### **New claims**

New claims 25-27 depend from claims 1, 14 and 13, respectively, and further define the claimed invention over the cited art.

#### **Conclusion**

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Examiner pass this application to issue.



June 28, 2005

Respectfully submitted,

John C. Pokotylo, Attorney

Reg. No. 36,242

Tel.: (732) 542-9070

**CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)**

I hereby certify that this correspondence is being deposited on **June 28, 2005** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

John C. Pokotylo

36,242

Reg. No.